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EXAMINER

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/867,645
Filing Date: May 31, 2001
Appellant(s): BYRD ET AL.

MAILED

SEP 05 2007

GROUP 3600

Jeffrey A. Berkowitz
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed April 23, 2007 appealing from the Office action mailed September 26, 2006.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

US Patent 6,578,015 B1 to Haseltine et al.

PR Newswire. "Sun-Netscape Alliance's New Internet Billing Consolidation Application to Help Make Internet Billing a Reality for Consumers." New York: Dec 6, 1999.

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 8-10 are rejected under 35 U.S.C. 102(e) as being anticipated by Haseltine (US PAT 6,578,015 B1).

Re Claim 8: Haseltine discloses methods, devices and systems for electronic bill presentment and payment comprising:

- A consolidator module (FIG 3, 350 and 360)
- A biller module connected to the consolidator module (310, 320, 330)

wherein the biller module includes

1. biller independent sub modules for communicating with the consolidator modules (Column 10, lines 11-43; thick consolidators maintain databases of accounts related to the various billers)

2. biller-dependent modules for retrieving information from data stored by the biller (Column 11, line 1-15; thin consolidators access information maintained at the biller sites)

3. An interface enabling the biller-independent submodules to interact with the biller dependent submodules (Column 11, lines 1-22; the system interfaces the

information obtained at the biller site, with account information maintained at the consolidator and payment processing capabilities at the consolidator as well).

Re Claim 9: Haseltine discloses the claimed system supra and further discloses wherein the consolidator module includes

- A bill presentment and payment module (Column 10, lines 26-32)
- A client object, connected to the bill presentment and payment module (Column 10, lines 26-32; client "views and/or pays his or her bills").

Re Claim 10: Haseltine discloses the claimed system supra and further discloses wherein the bill presentment and payment module provides an interface for accepting registration and requests from the customer (Column 8 lines 65-66; HTML interface).

Claims 1-7 and 14-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Haseltine et al (US 6,578,015 B1) in view of Newswire (PR Newswire. "Sun-Netscape Alliance's New Internet Billing Consolidation Application to Help Make Internet Billing a Reality for Consumers." New York: Dec 6, 1999, 4 pages).

Re Claim 1: Haseltine discloses methods, devices and systems for electronic bill presentment and payment comprising:

- Receiving customer registration information, including information sufficient to identify the customer (Column 8, line 65- Column 9 line 11),

- Providing the customer identification information to one of the billers as part of a first request indicating enrollment in the bill presentment and payment system (Column 9 line 11-33).

- Permitting access by the customer to billing information from the one of the billers (Column 3, lines 1-18).

Haseltine does not explicitly disclose the step wherein the customer is permitted access to the billing information at an unscheduled time. Newswire discloses a similar online bill payment and presentment system that discloses customers can access their bills "more than just once a month, (page 2, paragraph 5)" which is in reference to the old way of sending a single scheduled bill at monthly intervals. It would have been obvious to anyone skilled in the ordinary art at the time of invention to include the teachings of Newswire to the disclosure of Haseltine so that a customer can access their account information anytime they choose. Many of these accounts are dynamic and it would be useful to know the real time status of these accounts, as opposed to just receiving a consolidated bill once a month. A customer could therefore better keep track of their outstanding bills and have a timely picture of their finances.

Re Claim 2: Haseltine in view of Newswire discloses the claimed method supra and Haseltine further discloses the step of transmitting a second request to the one of the billers to access billing information; and receiving the billing information from the one of the billers (Column 10 line 11- Column 11 line 15).

Re Claim 3: Haseltine in view of Newswire discloses the claimed method supra and Haseltine further discloses wherein the first request is independent of the biller (Column 8 line 65-Column 9, line 19).

Re Claim 4: Haseltine in view of Newswire discloses the claimed method supra and Haseltine further discloses wherein the billing information includes at least one of a customer profile or billing data associated with the customer (Column line 31-33 and Column 10, line 15-33).

Re Claim 5: Haseltine in view of Newswire discloses the claimed method supra and Haseltine further discloses wherein the customer identification information includes one or more of name, address, phone number, e-mail address, social security number, date of birth or account number (Column 9, line 13-19).

Re Claim 6: Haseltine discloses methods, devices and systems for electronic bill presentment and payment comprising:

- Receiving, from a requesting IBPP system, a request for information associated with a customer (Column 10 line 44-52). The step of logging on represents an implied request for information.
- Retrieving the requested information (Column 10, lines 52-65),
- Forwarding the retrieved information to the requesting IBPP system (Column 10, lines 52-65).

Haseltine does not explicitly disclose wherein the retrieved information is forwarded at an unscheduled time. Newswire discloses a similar online bill payment

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and presentment system that discloses customers can access their bills "more than just once a month, (page 2, paragraph 5)" which is in reference to the old way of sending a single scheduled bill at monthly intervals. It would have been obvious to anyone skilled in the ordinary art at the time of invention to include the teachings of Newswire to the disclosure of Haseltine so that a customer can access their account information anytime they choose. Many of these accounts are dynamic and it would be useful to know the real time (or at least daily instead of monthly) status of these accounts, as opposed to just receiving a consolidated bill once a month. A customer could therefore better keep track of their outstanding bills and have a timely picture of their finances.

Re Claim 7: Haseltine in view of Newswire discloses the claimed method supra and Haseltine further discloses the steps of transforming the retrieved information to a format accepted by the requesting IBPP system and forwarding the transformed information to the requesting IBPP system (Column 3, lines 1-18 and Column 11 lines 31-38).

Re Claims 14-20: Further computer readable medium claims would have been obvious in order to implement previously rejected method claims 1-7, respectively and are therefore rejected using the same art and rationale.

Claims 11-13 and 21-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Haseltine.

Re Claim 11: Haseltine discloses the claimed system supra but does not explicitly disclose wherein the biller module includes

- A server object, which receives a request from the consolidator module
- A request handler, connected to the server object; and
- An implementation object which receives the request from the request handler.

However Haseltine does disclose an example wherein the consolidator module request information from the biller, the biller handles this request and further implements the request (Column 11, line 5-14). In this case the consolidator is requesting account information for a particular customer that is maintained at the biller site. By means of a linked URL this information is handled by the biller site in a way in which the biller site can determine the appropriate account requested, and implemented by connecting said account information to the consolidator and the associated customer. While not explicitly disclosing a server object, request handler and implementation object, these system components (or similar components representing a design choice) would have been obvious in order to execute the disclosed example, yielding a tangible result.

Re Claim 12: Haseltine discloses the claimed system supra but does not explicitly disclose wherein the biller independent module includes

- A server object, which receives a request from the consolidator module
- A request handler, connected to the server object; and

- An implementation object which receives the request from the request handler.

However, Haseltine does disclose that the thick consolidator utilizes an internal database of account biller information independent from the biller site (See Fig 4). Furthermore Haseltine discloses that customers can utilize the consolidator module to request information from said independent modules, which in turn receive the request and then further process and implement said request in the form of the customers account information and billing data while preserving the billers identities (Column 10, lines 15-33). While not explicitly disclosing a server object, request handler and implementation object, these system components (or similar components representing a design choice) would have been obvious in order to execute the disclosed example, yielding a tangible result.

Re Claim 13: Haseltine discloses the claimed system supra and further discloses wherein the implementation object is configured to implement the interface, based on information included in the request (Column 10, lines 26-32). By logging on the customer is, in effect, requesting access to their account information which is then implemented via an HTML or other web based interface.

Re Claim 21: Haseltine discloses the claimed system supra but does not explicitly disclose wherein the biller module includes:

- Receiving customer registration information, including information sufficient to identify the customer (Column 8, line 65- Column 9 line 11).

- Providing the customer identification information to one of the billers as part of a first request indicating enrollment in the bill presentment and payment system (Column 9 line 11-33).

Haseltine does not explicitly disclose wherein the request is provided to the biller in accordance with a bill data exchange protocol. However Haseltine does note that the billers would be "contracted with the consolidator" (Column 10, lines 26-32). It would have been obvious to anyone skilled in the ordinary art to include a bill exchange protocol between the consolidator and the billers so that there would be some type of standard information exchange that can be relayed to the customer. The motivation for this would be at least two-fold. First it would allow for the efficient transfer of information from the biller to the consolidator, as there will be an expectation of the type of data to be sent and received. And second, the customer will receive like data from all billers (i.e. account balance, usage summary), and not have different information for each, allowing for more efficient navigation of the consolidator.

Re Claim 22: Haseltine discloses methods, devices and systems for electronic bill presentment and payment comprising:

- Receiving, from a requesting IBPP system, a request (Column 10 line 44-52). The step of logging on represents an implied request for information.
- Retrieving the billing data based on the request (Column 10, lines 26-32)
- Forwarding the retrieved information to the requesting IBPP system (Column 10, lines 26-32).

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However, Haseltine does not explicitly disclose wherein the retrieved data is provided to the requesting IBPP system in accordance with a bill data exchange protocol. However Haseltine does note that the billers would be "contracted with the consolidator" (Column 10, lines 26-32) and furthermore would provide certain types of standard information (bill summary data and bill detail data). It would have been obvious to anyone skilled in the ordinary art to include a bill data exchange protocol between the consolidator and the billers so that there would be some type of standard information exchange that can be relayed to the customer. The motivation for this would be at least two-fold. First it would allow for the efficient transfer of information from the biller to the consolidator, as there will be an expectation of the type of data to be sent and received. And second, the customer will receive like data from all billers (i.e. account balance, usage summary), and not have different information for each, allowing for more efficient navigation of the consolidator.

Re Claim 23: Haseltine discloses methods, devices and systems for electronic bill presentment and payment comprising:

- Receiving customer registration information, including information sufficient to identify the customer (Column 8, line 65- Column 9 line 11).
- Providing the customer identification information to one of the billers as part of a first request indicating enrollment in the bill presentment and payment system (Column 9 line 11-33).

Haseltine does not explicitly disclose the step of permitting real time access by the customer to billing information from the one of the billers. However it was

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notoriously well known in the art at the time of invention to utilize the Internet for real-time information exchange and dissemination. Furthermore Haseltine notes that the "workflow process allows the bill data after validation to be loaded quickly in the active area (Column 5, lines 64-65)." While not explicitly noting "real-time," it would have been obvious to anyone skilled in the ordinary art at the time of invention to permit access to the information as quickly (i.e. real time) as possible to both save time and provide information as accurately as possible, since this type of financial information is very dynamic (i.e. constantly changing). Any delays in information processing may result in information that is not currently correct since an amount of time would have passed since the request was entered.

Re Claim 24: Haseltine discloses the claimed method supra and further discloses the step of transmitting a second request to the one of the billers to access billing information; and receiving the billing information from the one of the billers (Column 10 line 11- Column 11 line 15).

Re Claim 25: Haseltine discloses the claimed method supra and further discloses wherein the first request is independent of the biller (Column 8 line 65-Column 9, line 19).

Re Claim 26: Haseltine discloses the claimed method supra and further discloses wherein the billing information includes at least one of a customer profile or billing data associated with the customer (Column line 31-33 and Column 10, line 15-33).

Re Claim 27: Haseltine discloses the claimed method supra and further discloses wherein the customer identification information includes one or more of name, address, phone number, e-mail address, social security number, date of birth or account number (Column 9, line 13-19).

Re Claim 28: Haseltine discloses methods, devices and systems for electronic bill presentment and payment comprising:

- Receiving, from a requesting IBPP system, a request for information associated with a customer (Column 10 line 44-52). The step of logging on represents an implied request for information.

- Retrieving the requested information (Column 10, lines 52-65) Haseltine does not explicitly disclose the step of forwarding the retrieved information to the requesting IBPP system in real time. However it was notoriously well known in the art at the time of invention to utilize the Internet for real-time information exchange and dissemination. Furthermore Haseltine notes that the "workflow process allows the bill data after validation to be loaded quickly in the active area (Column 5, lines 64-65)." While not explicitly noting "real-time," it would have been obvious to anyone skilled in the ordinary art at the time of invention to permit access to the information as quickly (i.e. real time) as possible to both save time and provide information as accurately as possible, since this type of financial information is very dynamic (i.e. constantly changing). Any delays in information processing may result in information that is not currently correct since an amount of time would have passed since the request was entered.

Re Claim 29: Haseltine in view of Newswire discloses the claimed method supra and Haseltine further discloses the steps of transforming the retrieved information to a format accepted by the requesting IBPP system and forwarding the transformed information to the requesting IBPP system (Column 3, lines 1-18 and Column 11 lines 31-38).

(10) Response to Argument

The Appellant's arguments have been considered but are not persuasive.

Regarding arguments related to claims 8 and 1, Appellant argues that the thick and thin consolidators referred to in Haseltine do not constitute the claimed "biller-independent submodules" and "biller-dependent submodules" at least because the consolidators are part of the consolidator module, not the biller module. Referring to the Appellant's specification, page 5, paragraph 11 refers to "...a method or system that minimizes the overhead incurred by the requesting IBPP system and/or biller by reducing the extent of biller-dependent modules, or modules that must be designed specially for each biller". Haseltine specifically discloses reducing the extent of biller-dependent modules by creating a consolidated system that supports a biller system, such that the consolidator takes on the systemic portions and using a thin consolidator, the biller maintains their data while the consolidator provides the framework through which data is shared with users paying bills (column 10, lines 11-43 and column 11, lines 1-15). Further, the specification refers to "The biller module contains biller-independent

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submodules for communicating with the consolidator module and biller-dependent modules for retrieving information from data stored by the biller.” on page 6, paragraph 14. Haseltine discloses thick consolidators which are utilized to collect and maintain databases of information related to the billers, where the consolidator plays a greater role in the data management functions compared to when the thin consolidator model is used (column 11, lines 1-22).

Examiner maintains the position as stated in the final Office Action wherein the thick consolidators maintaining databases of accounts related to the various billers represents biller-independent modules (the data is available and managed by the consolidator without being dependent on the billers for functionality), and thin consolidators accessing information maintained at the biller sites represents biller-dependent modules (the data is available in summary form at the consolidator but for full account data one needs to access the biller database for functionality). An interface allowing interaction between the biller-independent and biller-dependent modules is provided in Haseltine in that data is passed between the entities, the databases maintained by the consolidator and the billers communicate, sharing account data. The information is passed among the interface such that users can access account data in order to make payments for billers using the consolidation site, and for enabling payment processing.

Appellant further argues that nothing in Haseltine discloses a thin consolidator for retrieving information from data stored by the biller. Haseltine discloses that account data for a user is maintained at a consolidator, though the amount of data stored is

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dependent on whether a thin or thick consolidator model is being used. If a thick model is being used, the consolidator maintains full account data, basically managing the accounts for the biller. If a thin model is being followed, the consolidator provides the ability for summary data to be displayed to a user, but if a user requires extra details or assistance then the user is required to access the biller databases for this additional information. In following and implementing either the thick or thin model, information is shared between the billers and the consolidator and data is retrieved from a biller for presentation for a user. In the thin model, summary data is retrieved from the biller for presentation by the consolidator, and detailed information is retrieved through a link on the consolidator web site if details are desired or required.

Regarding claim 9, Appellant argues that Haseltine does not disclose a client object, connected to the bill presentment and payment module. However, Examiner maintains the arguments as set forth in the final Office Action. Haseltine discloses a client object connected to the bill presentment and payment module wherein a user accesses a web page in order to view and/or pay bills, and wherein the bills are presented in various templates based on the bill format that a user is accustomed to in paper format (column 5, lines 15-23 and column 10, lines 25-33).

Further regarding claim 1 and claim 21, Appellant argues that customer identification information is not provided to one of the billers as part of a first request. Examiner respectfully disagrees. When a user registers with the consolidator system

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on the consolidator web site, the information must be provided to the biller in order to facilitate the establishing of an account by which user billing data can be provided to the consolidator for display to a user and subsequent receipt of payment from a user. As disclosed in column 9, lines 11-33, accounts are established in which billing data is then made available from billers and therefore registration data had to be communicated to a biller in order for bill data to be provided to the consolidator. If account data were not passed to a biller at the first step, the system would stop with a database of non-functional user information.

Regarding claim 1 and the establishment of a prima facie case of obviousness using the Haseltine and Newswire references, Appellant states that the combination is not obvious because "Newswire does not teach or suggest providing the customer identification information to one of the billers as part of a first request indicating enrollment in the bill presentment and payment system." Examiner respectfully notes that this is a moot argument as Newsweek is not intended to show this claim limitation. Haseltine, as detailed in the argument above, teaches this element. Newsweek was used simply to point to the claim language related to accessing and providing billing information at unscheduled times.

With regard to arguments around claims 2 and 23 and referencing the transmission of a second request to the one of the billers to access billing information, Haseltine clearly discloses where a user makes a request for registration (column 8, line

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65 – column 9, line 11), and then where a user makes a request for displaying and paying a bill (column 3, lines 1-18). These are two acts and two requests. During a first enrollment request, data is sent to a biller notifying the biller of the enrollment. From then, the user will return to the consolidator site in order to access and pay bills, requesting updated and current billing data.

Regarding the arguments related to claims 6 and 22, Appellant argues that Haseltine does not teach “receiving, from a IBPP system, a request for information associated with a customer”. However, Examiner argues that claim 6 represents the “answer” or “counter-action” to claim 1. In claim 1, an IBPP (or consolidator), sent enrollment information to a biller. Claim 6 refers to the receipt, from an IBPP system, a request for information associated with a customer which is then retrieved and forwarded to the requesting IBPP. Examiner argues that the disclosure as specified regarding claim 1, and the referenced sections associated therewith, similarly apply to claim 6. A request is sent from an IBPP (or consolidator) for user account data such that the bill data can be displayed to the user to facilitate payment. Without the consolidator receiving information associated with a customer, the consolidator would simply have a non-functional database of users. As stated above, Haseltine clearly discloses providing customer identification information to billers as part of a first request, and requests customer account data in order to operate the consolidation system, wherein the participating biller provides account data to the consolidator in order to populate the bill and payment system. The Newswire reference is used to teach that

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data can be sent and/or received at anytime, there are no requirement that data be sent and/or received just weekly or monthly, for example.

Regarding claim 11, Appellant argues that Haseltine does not disclose a server object receiving a request from the consolidator module, and rather that the customer makes the direct request to the billers. Examiner maintains that it is the consolidator that is facilitating the contact with the biller. As disclosed in column 11, lines 5-14, the consolidator maintains a customer-accessible link. While the customer may click on the link, it is the consolidator that is providing and operating the action of connecting to the biller site. The further arguments regarding objects were detailed above.

In response to Applicant's argument that it would not have been obvious to modify the cited prior art reference(s) to create the claimed invention, the Courts have stated that "[w]hen a work is available in one field of endeavor, design incentives and other market forces can prompt variations of it, either in the same field or a different one. If a person of ordinary skill can implement a predictable variation, §103 likely bars its patentability. For the same reason, if a technique has been used to improve one device, and a person of ordinary skill in the art would recognize that it would improve similar devices in the same way, using the technique is obvious unless its actual application is beyond his or her skill." *KSR Int'l Co. v. Teleflex, Inc.* 127 S. Ct. 1727, 1740, 92 USPQ2d 1385, 1396 (2007).

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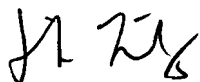
Similar arguments are made for claims 14-18 and 28-29, and therefore the same arguments as made above apply to those parallel claims.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interference section of this Examiner's Answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,



Jennifer Liversedge

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